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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,412	02/14/2001	Danny Soroker	6727/01290	4685

7590

11/14/2005

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EXAMINER

BAYARD, DJENANE M

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/783,412

Applicant(s)

SOROKER ET AL.

Examiner

Djenane M. Bayard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-23,25-34 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-23,25-34 and 36-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 21-23, 25-28, 30-33 and 36-39 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,687,741 to Ramaley et al.

a. As per claim 21, 22 and 23, Ramaley et al teaches a method for processing an electronic mail (e-mail) message having an attachment, comprising: receiving as input from a sender the e-mail message and the attachment for transmission to a recipient; receiving as input from the sender an instruction indicative of whether to save the attachment on a computer of the sender (See col. 7, lines 30-42, In response to detection of the send command, a determination is made as to whether the file has been saved. If the document has not been saved, the sender is prompted to save the file. Once the file is saved, the sender can either send the file as a link (not saving) or as an attachment (saving); sending the e-mail message and the attachment to the recipient (See col. 7, lines 40-45) If the user does not save the file, the conclusion is reached that the file is to be sent as an attachment); and responsive to the instruction indicating not to save the attachment, saving on the computer of the sender the e-mail message without the attachment (See col. 7, lines

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30-45, if the document has been saved to a permanent disk location, the sender has the option of sending the attachment as a link (not saving the file ) or as attachment (saving the file).

b. As per claim 25, 30 and 36, Ramaley et al teaches the claimed invention as described above. Furthermore, Ramaley et al teaches wherein receiving the instruction as the input comprises receiving the instruction as the input at a time of writing of the e-mail message by the sender (See col. 6, lines 11-20).

c. As per claims 26, 31 and 37, Ramaley et al teaches the claimed invention as described above. Furthermore, Ramaley et al teaches wherein receiving the Instruction as the input comprises receiving the instruction as the input at a time of sending of the e-mail message by the sender (See col. 6, lines 52-56)

d. As per claims 27, 32 and 38, Ramaley et al teaches the claimed invention as described above. Furthermore, Ramaley et al teaches wherein saving the e-mail message without the attachment comprises saving, with the e-mail message, information identifying the attachment.

e. As per claim 28, 33 and 39, Ramaley et al teaches the claimed invention as described above. Furthermore, Ramaley et al teaches wherein saving the e-mail message without the attachment comprises saving a name of the attachment with the e-mail message (See col. 7, lines 55-64)

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 29, 34 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,687,741 to Ramaley et al in view of U.S. Patent No. 6,327,612 to Watanabe.

a. As per claim 29, Ramaley et al teaches the claimed invention as described above. However, Ramaley et al fails to teach receiving as input from the sender a designation of a first set of one or more recipients and a designation of a second set of one or more recipients, wherein sending the e-mail message and the attachment to the recipient comprises: sending the e-mail message and the attachment to the first recipients; and set of one or more sending the e-mail message without the attachment to the second set of one or more recipients.

Watanabe teaches receiving as input from the sender a designation of a first set of one or more recipients and a designation of a second set of one or more recipients, wherein sending the e-mail message and the attachment to the recipient comprises: sending the e-mail message and the attachment to the first recipients; and set of one or more sending the e-mail message without the attachment to the second set of one or more recipients.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate receiving as input from the sender a designation of a first set of one or

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more recipients and a designation of a second set of one or more recipients, wherein sending the e-mail message and the attachment to the recipient comprises: sending the e-mail message and the attachment to the first recipients; and set of one or more sending the e-mail message without the attachment to the second set of one or more recipients as taught by Watanabe in the claimed invention of Ramaley et al in order to selectively attach data files to e-mails for each of individual recipients for transmission (See col. 1, lines 5-9).

### *Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Djenane Bayard

Patent Examiner



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